

REMARKS

Applicant submits these Remarks in reply to the Office Action mailed August 18, 2008. Claims 1, 3-7, and 9-13, and 15-18 are pending in this application, of which claims 1, 7 and 13 are independent. By this Amendment, Applicant amends claims 1, 5, 7, and 13. Amended claims 1, 7, and 13 substantially include the subject matter of claims 2, 8, and 14, which are now canceled.

In the Office Action, the Examiner took the following actions:

- (1) rejected claim 13 under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite;
- (2) rejected claims 1-6 and 13-18 under 35 U.S.C. § 101 as allegedly directed to non-statutory subject matter;
- (3) rejected claims 1, 3-7, 9-13, and 15-18 under 35 U.S.C. § 103(a) as being unpatented over U.S. Patent No. 7,251,612 ("Parker") in view of U.S. Patent No. 7, 212,984 ("Wolfe");¹ and
- (4) rejected claims 2-3, 8 and 14 under 35 U.S.C. § 103(a) as being unpatented over *Parker* in view of *Wolfe* and further in view of U.S. Patent No. 5,880,958 ("Helms").²

Applicant respectfully traverses the above rejections as follows.

¹ Although the Examiner rejected claims 5-6, 11-12, and 17-18 under this combination of references, the Office Action does not give any reasons for the rejection of those claims. Additionally, claim 15 does not appear in the heading for paragraph 5, but it is mentioned on page 4 of the Office Action.

² Applicant notes claim 3 initially appears rejected by the combination of *Parker* and *Wolfe*, but the Examiner later admits the combination lacks disclosure (see Office Action, p. 4) and relies upon *Helms*. Thus, Applicant addresses the rejection of claim 3 on the later bases.

I. 35 U.S.C. § 112, second paragraph

In the Office Action, the Examiner rejected claim 13 under 35 U.S.C. § 112, second paragraph, because the phrase “being capable of” allegedly rendered the claim indefinite. The proposed amendment to claim 13 makes this argument moot because it no longer contains that phrase. Therefore, Applicant respectfully requests that the Examiner withdraw the 35 U.S.C. § 112, second paragraph, rejection.

II. 35 U.S.C. § 101

Applicant’s amended claims also render moot the Examiner’s 35 U.S.C. § 101 rejection of claims 1-6 and 13-18. In supporting that rejection, the Examiner argued that the method of claims 1-6 was not tied to another statutory class. Office Action, pp. 2-3. Claims 1-6, as amended, explicitly recite that the method is computer implemented, and, therefore, tied to another statutory class. Similarly, claims 13-18, as amended, now clearly reflect that the instructions are executed by a processor, which carries out the claimed stages. Consequently, Applicant respectfully requests that the Examiner withdraw the 35 U.S.C. § 101 rejection of claims 1-6 and 13-18.

III. 35 U.S.C. § 103(a)

Applicant respectfully traverses the Examiner’s rejection of claims 1-18 under 35 U.S.C. § 103(a). A *prima facie* case of obviousness has not been established with respect to these claims, as amended, because the combined teachings fail to disclose, teach, or suggest the invention as claimed.

The key to supporting any rejection under 35 U.S.C. § 103(a) is the clear articulation of the reasons why the claimed invention would have been obvious. Such an analysis should be made explicit and cannot be premised upon mere conclusory

statements. See M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007). “A conclusion of obviousness requires that the reference(s) relied upon be enabling in that it put the public in possession of the claimed invention.” M.P.E.P. § 2145. Furthermore, “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art” at the time the invention was made. M.P.E.P. § 2143.01(III), internal citation omitted. Moreover, “[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” M.P.E.P. § 2141.02(I), internal citations omitted (emphasis in original).

“[T]he framework for objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q. 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art.” M.P.E.P. § 2141(II). “Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” M.P.E.P. § 2141(III).

A. The references do not teach “determining whether assigning a load to the first segment of the tour will produce a cost savings over assigning the load to a common carrier.”

The cited references do not teach or suggest “determining whether assigning a load to the first segment of the tour will produce a cost savings over assigning the load to a common carrier,” as recited in Applicant’s amended independent claims 1, 7, and

13. The Examiner correctly concludes that *Parker* and *Wolfe* fail to teach this subject matter, but incorrectly cites *Helms* for teaching the similar subject matter of canceled claims 2, 8, and 14. Although *Helms* teaches minimizing costs through other techniques (e.g., by eliminating “dead head”), *Helms* is completely silent with regard to determining whether there will be “a cost savings over assigning the load to a common carrier,” as claimed. The cited passage of *Helms*, spanning columns 8 and 9, is limited to minimizing costs for a tour using particular tractors and does not consider bypassing those tractors altogether in favor of a common carrier. Therefore, none of the cited references teach the claimed subject matter.

Consequently, all combinations of the cited references fail to teach at least one element of amended independent claims 1, 7, and 13. The references also fail to teach at least one element of dependent claims 3-6, 9-12, and 15-18, which necessarily contain the elements of the independent claims. Thus, no *prima facie* case of obviousness exists with respect to claims 1, 3-7, 9-13, and 15-18. Consequently, Applicant respectfully requests the Examiner withdraw the 35 U.S.C. § 103(a) rejections of those claims.

B. The Office Action does not explain why claims 5-6, 11-12, and 17-18 stand rejected.

Additionally, although the Office Action states claims 5-6, 11-12, and 17-18 are rejected (Office Action at 3), it does not give any explanation as to why. Accordingly, the Office Action does not clearly articulate a reason why one of ordinary skill in the art would have arrived at those claims, as required to make a *prima facie* case of obviousness. See M.P.E.P. § 2142 (citing *KSR international Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1396 (2007).).

Applicant respectfully requests that at least those claims be allowed. But if the Examiner decides to reject those claims, Applicant notes that a Final Office Action would be inappropriate since those claims have not yet received a proper first action on the merits. See M.P.E.P. § 706.07(a). In issuing an Office Action, "[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art." M.P.E.P. § 2143.03, citing *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). The Office Action does not address the recitations of claims 5-6, 11-12, and 17-18, and, therefore, does not fulfill the requirements of M.P.E.P. § 2143.03.

IV. Conclusion

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

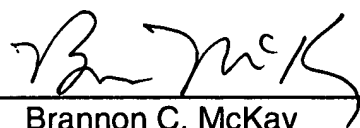
If the Examiner continues to dispute the patentability of the pending claims after considering the above, please call Applicant's undersigned representative, below.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: November 12, 2008

By: 
Brannon C. McKay
Reg. No. 57,491
(404) 653-6410